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Please find below and/or attached an Office communication concerning this application or proceeding.

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* NANCY L. SAXON, STEVEN G. SAIEG,
9 CRAIG HOLT and BRADEN J. BROMLEY
10

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12 Appeal 2008-003588
13 Application 10/658,306
14 Technology Center 3600
15

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17 Decided:¹ July 14, 2009
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20 Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,
21 and JOHN C. KERINS, and FRED A. SILVERBERG, *Administrative*
22 *Patent Judges*.
23

24 SILVERBERG, *Administrative Patent Judge*.
25
26

27 DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Nancy L. Saxon et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 14 and 16-26. Claims 1-13 and 15 have been withdrawn. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to a reinforced slider frame for a tractor-trailer slider assembly (Spec.: ¶ [1]).

The invention is readily understood by reference to Figure 7, and Claim 14.

Figure 7 is reproduced below:

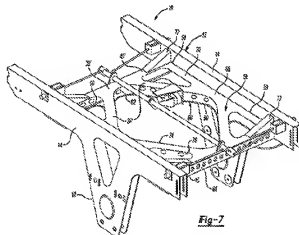


Fig-7

Figure 7 shows the elected species² of the slider frame 12 (Spec. 7-8: ¶ [27]).

² On December 8, 2005, the species shown in Figure 7 was elected without traverse in response to an election of species requirement mailed November 8, 2005.

Claim 14, reproduced below, is representative of the claimed subject matter:

14. A suspension slider for a vehicle trailer comprising:
first and second spaced apart longitudinal members each
including a downwardly depending hanger for supporting
forward and rearward suspension assemblies; and
structure interconnecting said first and second spaced
apart longitudinal members, said structure including a
continuous wall forming first and second angled portions
converging to a central portion, said continuous wall secured to
said first and second spaced apart longitudinal members.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Hutchens	US 3,406,439	Oct. 22, 1968
Loeber	US 3,856,344	Dec. 24, 1974
Robey	US 4,919,445	Apr. 24, 1990
Christenson	US 5,067,740	Nov. 26, 1991
VanDenberg	US 5,718,445	Feb. 17, 1998
Pierce	US 5,720,489	Feb. 24, 1998
Garcia	US 5,722,688	Mar. 3, 1998

The following rejections by the Examiner are before us:

1. Claims 14 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Robey in view of VanDenberg.
2. Claims 14, 16 and 21-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Christenson in view of Hutchens.
3. Claims 17, 18, 20, 24 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Christenson in view of Hutchens, and further in view of Garcia.

4. Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Christenson in view of Hutchens and Garcia, and further in view of Loeber.

5. Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Christenson in view of Hutchens and Garcia, and further in view of Pierce.

ISSUES

The issues before us are: (1) whether the Examiner has articulated a reason with rational underpinning to provide Robey's sliding frame with the hangers of VanDenberg as called for in claim 14 (App. Br. 4), (2) whether the Examiner has articulated a reason with rational underpinning to provide Christenson's slider frame with the hangers of Hutchens as called for in claim 14 (App. Br. 6), and (3) whether the Examiner has articulated a reason with rational underpinning to provide the combined teachings of Christenson, Hutchens and Garcia with the triangular braces of Pierce as called for in claim 19 (App. Br. 6).

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

The Appellants' Admissions

1. Christenson describes suspension mounts 86 and suspension members 87 (fig. 7), but does not describe what the suspension configuration is or how it is secured to a frame (App. Br. 6).

The Examiner's Findings

Claims 14 and 16

2. The Examiner finds that Robey schematically describes a support 26 for front and rear suspensions 20, 24 (Ans. 3).
3. The Examiner finds that since Robey only describes the support 26 schematically, Robey does not describe two downwardly depending hangers as called for in claim 14 (Ans. 3).
4. The Examiner finds that VanDenberg describes that hangers 5, 6 are well known in the tandem axle art (Ans. 3-4), and that VanDenberg attributes to the suspension the advantages of roll stability and resistance to lateral deflection (Ans. 7).
5. The Examiner finds that combining the teachings of Robey and VanDenberg by replacing Robey's suspension system with a tandem axle suspension and hangers as taught by VanDenberg would provide Robey with the advantage of a tandem axle that is roll stable and resistant to lateral deflection (VanDenberg, col. 1, ll. 7-14) (Ans. 4).

Claims 14, 16 and 21-23

6. The Examiner implicitly finds that Christenson describes all of the limitations called for in claim 14 except that Christenson does not describe hangers that support front and rear suspensions (Ans. 4).

7. The Examiner finds that Hutchens describes integral hangers 44 that support front and rear tandem axle suspensions, wherein the integral hangers 44 are useful because they provide for the production of a suspension unit with a minimum number of parts and fabricating steps (Ans. 4).
8. The Examiner finds that to modify the slider 70 of Christenson to include integral hangers as taught by Hutchens at 44 would provide Christenson with a suspension unit with a minimum number of parts (Ans. 4).

Claim 19

9. The Examiner implicitly finds that the combined teachings of Christenson, Hutchens and Garcia describe all of the limitations called for in claim 19 except that the combined teachings of Christenson, Hutchens and Garcia do not describe triangular shaped braces as called for in claim 19 (Ans. 6).
10. The Examiner finds that Pierce describes that it is known in the slider frame art to provide triangular braces 170, which are used to provide additional strength to the slider frame (Ans. 6, 9).
11. The Examiner finds that to modify the combined teachings of Christenson, Hutchens and Garcia to include triangular shaped braces as taught by Pierce at 170 would provide additional strength to the slider (Ans. 6).

This Board's Findings

12. Robey describes an undercarriage including a sliding frame 22 overlying wheels and axles 24 joined to the depending limit of the

frame 22 in a conventional manner by a spring and shackle assembly 26 (col. 3, ll. 16-22 and figs. 1-2).

13. Appellants have not contested the Examiner's findings as to the teachings of Robey, Christenson or Pierce (Reply Br. 1-3 and App. Br. 4-7).

14. Appellants have neither contested the rejection of claims 17, 18, 20, 24 and 26 over Christenson in view of Hutchens, and further in view of Garcia, nor contested the rejection of claim 25 over the teachings of Christenson in view of Hutchens and Garcia, and further in view of Loeber (App. Br. 4).

15. Additional findings as necessary appear in the Analysis portion of this opinion.

PRINCIPLES OF LAW

Appellants' Burden

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). *See also Ex parte Yamaguchi*, 88 USPQ2d 1606, 1614 (BPAI 2008) [burden on appeal] (on appeal, applicant must show examiner erred); *Ex parte Fu*, 89 USPQ2d 1115, 1123 (BPAI 2008); *Ex parte Catan*, 83 USPQ2d 1569, 1577 (BPAI 2007); and *Ex parte Smith*, 83 USPQ2d 1509, 1519 (BPAI 2007).

1 *Obviousness*

2 “Section 103 forbids issuance of a patent when ‘the differences
3 between the subject matter sought to be patented and the prior art are such
4 that the subject matter as a whole would have been obvious at the time the
5 invention was made to a person having ordinary skill in the art to which said
6 subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406
7 (2007). The question of obviousness is resolved on the basis of underlying
8 factual determinations including (1) the scope and content of the prior art,
9 (2) any differences between the claimed subject matter and the prior art, (3)
10 the level of skill in the art, and (4) where in evidence, so-called secondary
11 considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See*
12 *also KSR*, 550 U.S. at 406-407 (“While the sequence of these questions
13 might be reordered in any particular case, the [*Graham*] factors continue to
14 define the inquiry that controls.”).

15 In *KSR*, the Supreme Court stated that “when a patent claims a
16 structure already known in the prior art that is altered by the mere
17 substitution of one element for another known in the field, the combination
18 must do more than yield a predictable result.” *Id.* at 416 (citing *United*
19 *States v. Adams*, 383 U.S. 39, 50-51 (1966)).

20 In *KSR* the Supreme Court held that “if a technique has been used to
21 improve one device, and a person of ordinary skill in the art would recognize
22 that it would improve similar devices in the same way, using the technique is
23 obvious unless its actual application is beyond his or her skill.” *KSR*, 550
24 U.S. at 417.

1 In *KSR*, the Supreme Court stated that:

2 Often, it will be necessary for a court to look to
3 interrelated teachings of multiple patents; the
4 effects of demands known to the design
5 community or present in the marketplace; and the
6 background knowledge possessed by a person
7 having ordinary skill in the art, all in order to
8 determine whether there was an apparent reason to
9 combine the known elements in the fashion
10 claimed by the patent at issue.

11 *Id.* at 418. The Court noted that “[t]o facilitate review, this analysis should
12 be made explicit.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)
13 (“[R]ejections on obviousness grounds cannot be sustained by mere
14 conclusory statements; instead, there must be some articulated reasoning
15 with some rational underpinning to support the legal conclusion of
16 obviousness.”)). However, “the analysis need not seek out precise teachings
17 directed to the specific subject matter of the challenged claim, for a court
18 can take account of the inferences and creative steps that a person of
19 ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418.

20 In *KSR*, the Supreme Court stated that:

21 Helpful insights, however, need not become rigid
22 and mandatory formulas; and when it is so applied,
23 the TSM test is incompatible with our precedents.
24 ... There is no necessary inconsistency between
25 the idea underlying the TSM test and the *Graham*
26 analysis. But when a court transforms the general
27 principle into a rigid rule that limits the
28 obviousness inquiry, as the Court of Appeals did
29 here, it errs.

30
31 *Id.* at 419.
32

ANALYSIS

Appellants argue claims 14, 16-18 and 20-26 as a group. As such, we select claim 14 as representative of the group, and claims 16-18 and 20-26 will stand or fall with claim 14. 37 C.F.R. § 41.37(c)(1)(vii) (2007). The Appellants argue claim 19 separately.

Rejection of claims 14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Robey in view of VanDenberg

Robey schematically describes a support 26 for front and rear suspensions 20, 24 (Fact 2). The Examiner found that since Robey only describes the support 26 schematically, Robey does not describe two downwardly depending hangers as called for in claim 14 (Fact 3). The Examiner found that VanDenberg describes that hangers 5, 6 are well known in the tandem axle art (Fact 4).

Appellants have not contested the Examiner's findings as to the teachings of Robey (Fact 13).

Appellants contend that there is no motivation to modify Robey to provide the hangers of VanDenberg (App. Br. 4). To the extent the Appellants are arguing for a rigid application of the teaching-suggestion-motivation test, this argument is not persuasive in light of the Court's decision in *KSR*. See *KSR*, 550 U.S. at 419 (holding that it is error to apply the teaching-suggestion-motivation test as a rigid formula to limit the obviousness inquiry).

Appellants further contend that the Examiner's rationale for combining the teachings of Robey and VanDenberg was in error as the roll stability, which is the argued motivation, is not attributable to the hangers (App. Br. 5). Appellants still further contend that the Examiner has not

1 provided a valid reason for combining the teachings of Robey and
2 VanDenberg (Reply Br. 2).

3 The Examiner's proposed combination is the substitution of
4 VanDenberg's slider suspension for Robey's conventional slider
5 suspension³. We see no error in the Examiner's finding that VanDenberg
6 attributes to the suspension the advantages of roll stability and resistance to
7 lateral deflection (Fact 4). Further, we see no error in the Examiner's
8 finding that combining the teachings of Robey and VanDenberg would yield
9 in Robey the predictable result of the suspension advantages taught by
10 VanDenberg (Fact 5).

11 The modification proposed by the Examiner is the simple substitution
12 of one known suspension system for another to perform the same function of
13 suspending a vehicle, and thereby yields predictable results. *See KSR*, 550
14 U.S. at 416 (the claimed combination of known structure altered by the mere
15 substitution of one element for another known structure must do more than
16 yield a predictable result).

17 Therefore, we conclude that the Appellants have not demonstrated
18 that the Examiner erred in rejecting claim 14 over Robey in view of
19 VanDenberg. The Appellants have likewise not demonstrated error in the
20 Examiner's rejection of claim 16, which falls with claim 14.

21
22 *Rejection of claims 14, 16 and 21-23 under 35 U.S.C. § 103(a) as being*
23 *unpatentable over Christenson in view of Hutchens*

24 The Examiner implicitly found that Christenson describes all of the
25 limitations called for in claim 14 except that Christenson does not describe
26 hangers that support front and rear suspensions (Fact 6). The Examiner

³ See Fact 12 for Robey's suspension being conventional.

1 further found that Hutchens describes integral hangers 44 that support front
2 and rear tandem axle suspensions, wherein the integral hangers 44 are useful
3 because they provide for the production of a suspension unit with a
4 minimum number of parts and fabricating steps (Fact 7).

5 Appellants have not contested the Examiner's findings as to the
6 teachings of Christenson (Fact 13).

7 Appellants contend that there is no motivation to modify Christenson
8 to provide the hangers of Hutchens (App. Br. 6). To the extent the
9 Appellants are arguing for a rigid application of the teaching-suggestion-
10 motivation test, this argument is not persuasive in light of the Court's
11 decision in *KSR*. 550 U.S. at 419.

12 Appellants further contend that they have rebutted the Examiner's
13 initial finding of obviousness, and that the Examiner has failed to support a
14 prima facie case of obviousness (App. Br. 5). In a Final Rejection, an
15 Examiner sets forth a final conclusion of obviousness, not a prima facie case
16 of obviousness. A final conclusion of obviousness is based on the totality of
17 the record.⁴ We conclude that the Examiner reached a proper final
18 conclusion of obviousness based on the record.

19 Appellants still further contend that there is no reason why one of
20 ordinary skill would combine Christenson and Hutchens (Reply Br. 2).
21 Appellants still further contend that there is nothing in either Christenson or

⁴ After evidence or argument is submitted by the applicant in response to an examiner's prima facie case, the examiner determines patentability on the totality of the record, by a preponderance of the evidence with due consideration to persuasiveness of the applicant's arguments. See *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). MPEP § 716.01(d) describes how the examiner is to make a final determination of obviousness.

1 Hutchens that would indicate that Christenson would benefit from the
2 hangers of Hutchens (App. Br. 6).

3 The Examiner's proposed combination is to modify the slider 70 of
4 Christenson to include integral hangers as taught by Hutchens at 44 (Fact 8).
5 As Appellants admit, Christenson describes suspension mounts 86 and
6 suspension members 87, but does not describe how the suspension is secured
7 to a frame (Fact 1). We see no error in the Examiner's finding that
8 Hutchens' integral hangers provide a suspension unit with a minimum
9 number of parts (Fact 7). In particular, we find that Hutchens' integral
10 hangers provide a way of securing a suspension unit to a frame with a
11 minimum number of parts. Further, we see no error in the Examiner's
12 finding that combining the teachings of Christenson and Hutchens would
13 yield in Christenson the predictable result of a suspension unit being secured
14 to a frame with a minimum number of parts as taught by Hutchens (Fact 7).

15 The modification proposed by the Examiner is nothing more than the
16 simple substitution of one known element (suspension unit) for another to
17 perform the same function of suspending a vehicle, and thereby yields
18 predictable results, or the mere application of a known technique to a piece
19 of prior art ready for the improvement. *See KSR*, 550 U.S. at 416, 417. *See*
20 *also Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57
21 (1969) (paving repair apparatus consisting of a combination of three known
22 elements, all performing their established functions in the combination, held
23 obvious).

24 Therefore, we conclude that the Appellants have not demonstrated
25 that the Examiner erred in rejecting claim 14 over Christenson in view of

Hutchens. The Appellants have likewise not demonstrated error in the Examiner's rejection of claims 16 and 21-23, which fall with claim 14.

Rejection of claims 17, 18, 20, 24 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Christenson in view of Hutchens, and further in view of Garcia, and the Rejection of claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Christenson in view of Hutchens and Garcia, and further in view of Loeber

Appellants have contested neither the rejection of claims 17, 18, 20, 24 and 26 over Christenson in view of Hutchens, and further in view of Garcia, nor the rejection of claim 25 over the teachings of Christenson in view of Hutchens and Garcia, and further in view of Loeber (Fact 14). Therefore, we conclude that Appellants have not demonstrated that the Examiner erred in rejecting claims 17, 18, 20, 24 and 26 over Christenson in view of Hutchens, and further in view of Garcia, and claim 25 over Christenson in view of Hutchens and Garcia, and further in view of Loeber.

Rejection of claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Christenson in view of Hutchens and Garcia, and further in view of Pierce

The Examiner implicitly found that the combined teachings of Christenson, Hutchens and Garcia describe almost all of the limitations called for in claim 19 except that the combined teachings of Christenson, Hutchens and Garcia do not describe triangular shaped braces as called for in claim 19 (Fact 9). The Examiner further found that Pierce describes that it is known in the slider frame art to provide triangular braces 170, which are used to provide additional strength to the slider frame (Fact 10).

Appellants have not contested the Examiner's findings as to the teachings of Pierce (Fact 13).

1 Appellants contend that nothing in Pierce would suggest or motivate
2 one of ordinary skill to incorporate Pierce's triangular-shaped braces at the
3 location called for in claim 19 (App. Br. 6-7). To the extent the Appellants
4 are arguing for a rigid application of the teaching-suggestion-motivation test,
5 this argument is not persuasive in light of the Court's decision in *KSR*. 550
6 U.S. at 419.

7 Appellants further contend that one of ordinary skill would only use a
8 brace where absolutely needed, and that the Examiner has not given a reason
9 as to why one of ordinary skill would use a brace where claimed (Reply Br.
10 3).

11 The Examiner's proposed combination is to modify the combined
12 teachings of Christenson, Hutchens and Garcia to include triangular braces
13 as taught by Pierce at 170 (Fact 11). We see no error in the Examiner's
14 finding that Pierce's triangular braces (reinforcement box) 170 provide
15 additional strength to the slider frame. A person having ordinary skill in the
16 slider frame art would know to add a triangular brace to a slider frame where
17 additional strength was needed. Therefore, we see no error in the
18 Examiner's finding that combining the teachings of Christenson, Hutchens,
19 Garcia and Pierce would yield in Christenson the predictable result of a
20 slider frame having additional strength as taught by Pierce (Fact 11).

21 The modification proposed by the Examiner is simply the predictable
22 use of a triangular brace between two elements according to its established
23 function to provide additional strength to obtain predictable results. *See*
24 *KSR*, 550 U.S. at 416.

Therefore, we conclude that the Appellants have not demonstrated that the Examiner erred in rejecting claim 19 over Christenson in view of Hutchens and Garcia, and further in view of Pierce.

CONCLUSIONS OF LAW

Appellants have not established that the Examiner erred in articulating a reason with rational underpinning that would have led a person of ordinary skill in the art to: (1) provide Robey's sliding frame with the hangers of VanDenberg as called for in claim 14, (2) provide Christenson's slider frame with the hangers of Hutchens as called for in claim 14, and (3) provide the combined teachings of Christenson, Hutchens and Garcia with the triangular braces of Pierce as called for in claim 19.

DECISION

The decision of the Examiner to reject claims 14 and 16 over Robey in view of VanDenberg; claims 14, 16 and 21-23 over Christenson in view of Hutchens; claims 17, 18, 20, 24 and 26 over Christenson in view of Hutchens, and further in view of Garcia; claim 25 over Christenson in view of Hutchens and Garcia, and further in view of Loeber; and claim 19 over Christenson in view of Hutchens and Garcia, and further in view of Pierce, is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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